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| 09/872,976 | 05/31/2001 | Paul Joseph Datta | 659/829 | 3040 |

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BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

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| EXAMINER |
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REICHLE, KARIN M

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| ART UNIT | PAPER NUMBER |
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3761

DATE MAILED: 07/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,976

Applicant(s)

DATTA ET AL.

Examiner

Karin M. Reichle

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(e). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9-3-02, 1-13-03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 30 September 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received. _____
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3761

DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

The second application must be an application for a patent for an invention which is also disclosed in the first application (the parent or provisional application); the disclosure of the invention in the parent application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the invention in the 09/215,915 parent application does not appear to be the same as the disclosure of the invention of the instant application, e.g. where is the length of the side panel with respect to the chassis as claimed in claim 6 of the instant application set forth in the '915 application? It is noted that Applicant's remarks in the 9-30-02 response, items 8 and 9, did not point out the support for the invention of the instant application with regard to the '915 application. Therefore, with regard to the '915 application Applicant has not complied with one of the conditions for receiving the benefit of that application's filing date.

Art Unit: 3761

Specification

Drawings

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 9-30-02 have been approved in part(Figures 1A and 3 only). A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

The drawing change proposed for Figure 2 was not approved because such gave two different designations to the same front end fastener. See discussion infra.

3. The drawings are objected to because element 5 in Figures 1B and 2 are not consistent, i.e. a square like that shown in Figure 1B should be labeled 5 in Figure 2. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Description

4. The use of the trademark KRATON(R)(pages 8 and 12), CELGARD(R)(pages 15-16), TEFLON(R)(page 19), S/P(R) Certified Blood Saline(page 20), ESPOIR(R)N-TAF-CT(page 23, LYCRA(R)(pages 25-27), VELCRO(R)(page 28), BRANSON(R) and DUKANE(R)(page 5) and

Art Unit: 3761

TRITON(R)(page 25)has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Trademarks should be shown in all capital letters or accompanied by a trademark symbol but not both.

5. The disclosure is objected to because of the following informalities: 1) The Summary of the Invention Section, i.e. a description of the claimed invention, and the invention as claimed, i.e. claims 1-8 and 10-14, are still not commensurate, see MPEP 608.01(d) and 1302.01. 2) Different numerals 5 and 51 are now used to describe the same structure, i.e the front end fastener, i.e. a square like that shown in Figure 1B labeled 5 should be shown in Figure 2 and the description thereof on page 29 amended accordingly. 3) Page 2, lines 2-3 and second full paragraph and claims 4-5 and 7-8 don't set forth an upper limit of about 1500g or about 250g while page 19, lines 11-18 does. A clear consistent description of the limits should be set forth.

Appropriate correction is required.

Art Unit: 3761

Claim Objections

6. Claims 1-2, and 12-14 are objected to because of the following informalities: in claim 1, line 2, after "pant", --further-- should be inserted and before "back", --a-- should be inserted. In claims 12 and 14, lines 4 and 5, respectively, "and," should be --and--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being as being anticipated by Swenson '068.

See Figures, especially Figures 13-16 and page 3, lines 34-43, i.e. panel is left handed line portion. As disclosed, the panel is wide enough to encircle the device and fasten to itself. Note also page 7, line 45-page 8, line 13, e.g. front fastener 81. Claim 1, lines 7-8, claim 2, claim 3, lines 6 et seq, claims 4-5, claim 6, lines 6 et seq, claims 7-8, and claim 9, lines 4-6 recite capabilities and functions of the claimed structure. It is noted that the claims do not require folding or fastenability of panels prior to disposal. Swenson includes all the claimed structure. Therefore there is sufficient factual basis for one to conclude that the functions and capabilities of

Art Unit: 3761

such claimed structure would also be inherent in the same structure of Swenson, see MPEP 2112.01. With regard to claim 3, "substantially the same" as interpreted in light of the specification and as ordinarily defined is considered as "more than 50%" in the relaxed state (Note to interpret it otherwise would not be supported by the specification, see Figures which show inside length of panel longer than width.)

9. Claims 10-14 rejected under 35 U.S.C. 102(b) as being anticipated by Sageser et al. See interpretation of the terminology "substantially the same" in preceding rejection. See Figure 8, and col 14, line 29-col. 16, line 3, and thereby Scripps '724, e.g., Figures, and Buell et al '092, e.g., col. 44, lines 47-51, i.e. the minimum amount of stretch using the elastic side panels is at least about 50%. With regard to the functions and capabilities set forth in claims 10-14 which are like those set forth in claims 1-9, the remarks with regard to inherency set forth in the previous rejection with regard to Swenson are repeated here with regard to Sageser.

Claim Rejections - 35 USC § 103

10. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

11. Claims 4-5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swenson in view of Sosalla.

Art Unit: 3761

Applicant claims the absorbency of the product. It is the Examiner's first position that the Swenson device in as much structure as is claimed is inherently capable of such absorbency, see supra. In any case, see Swenson at page 1, line 5 and page 7, lines 32-34 and Sosalla at col. 12, lines 39-31 and 51-55. To employ the absorbent capabilities as taught by Sosalla on the Swenson device, if not already, would be obvious to one of ordinary skill in the art in view of the recognition that such a feature would accommodate wearers ranging from infants through adults and the desirability of such by Swenson.

Response to Arguments

12. In regard to Applicant's remarks on pages 13-17, items 1-13 have been considered but are either deemed moot in that the issue has not been repeated or is deemed nonpersuasive for the reasons set forth supra. With regard to Applicant's remarks in items 14-15 and 18 on pages 17 and 18, Applicant's remarks have been carefully considered but are deemed nonpersuasive in that the references teach front fasteners and elastics panels which have panels are inherently capable of the claimed function. The claims do not recite a specific width and elasticity which the references do not teach nor are Applicant's arguments that the Figures are not accurate and that the panels are too short collaborated by evidence.

Art Unit: 3761

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any inquiry concerning this communication should be directed to K. M. Reichle at telephone number 703-308-2617. The Examiner's regular work schedule is Monday-Thursday. The Official RightFax number is 703-872-9302.

KMR

June 28, 2003

K.M. Reichle
K.M. REICHEL
EXAMINER